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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,325	08/15/2005	Roger Bonnert	06275-435US1/100770-1P US	9186
26164 7590 10/15/2007 FISH & RICHARDSON P.C. P.O BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER YOUNG, SHAWQUIA	
			ART UNIT 1626	PAPER NUMBER
			MAIL DATE 10/15/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/521,325

Applicant(s)

BONNERT ET AL.

Examiner

Shawquia Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,10 and 114 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,10 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_.

### DETAILED ACTION

Claims 1-7, 10 and 14 are currently pending in the instant application. Applicants have cancelled claims 9 and 11 in an amendment filed on July 24, 2007.

#### I. ***Response to Arguments***

Applicant's amendments, filed on July 24, 2007, have overcome the following rejection(s) and/or objection(s): the rejection of claims 9 and 10 under 35 USC 112, first paragraph as failing to comply with the enablement requirement; the rejection of claim 4 under 35 USC 112, second as being indefinite and unclear specifically the phrase "substituent(s) is/are in the 4- and/or 5-position; the rejection of claim 14 under 35 USC 112, second paragraph, as being indefinite specifically the phrase "comprises reaction of a compound of formula (II)"; the rejection of claim 11 under 35 USC 101 as being directed to non-statutory subject matter; the objections of claims 1-7, 10 and 14 for informalities and thus the above rejections and objection has been withdrawn.

Applicants traverse the rejection of claim 14 under 35 USC 112, first paragraph, as failing to comply with the written description requirement and under 35 USC 112, second paragraph as being indefinite for the term "protected derivatives". Applicants argue that the term "protected derivatives" would be clear to one skilled in the art so as to understand the structures of the compounds that are included and/or excluded by the term. However, the Examiner wants to point out that the term "derivatives" is defined in the art as a compound, usually organic obtained from another compound by a simple chemical process or an organic compound containing a structural radical similar to that from which it is derived (Hackh's chemical dictionary, 1972). Therefore the term

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"derivative" encompasses numerous compounds that are not supported by the specification. The rejections of claim 14 under 35 USC 112, first paragraph as failing to comply with the written description requirement and under 35 USC 112, second paragraph as being indefinite are maintained.

Applicants have failed to delete the term "heteroaryl" in variable R<sup>8</sup> in claim 1, therefore the rejection of claims 1-7, 10 and 14 under 35 USC under 35 USC 112, first paragraph as failing to comply with the written description requirement is maintained.

## II. *Rejection(s)*

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(1) Claims 1-7, 10 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The following terms of Claim 1 are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term: "heteroaryl" when defining variables R<sup>8</sup>.

Therefore, the specification lacks adequate support for Claim 1. Applicant may overcome this rejection by deleting the undefined terms.

(2) Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The "protected derivatives" of the compounds of formula (II) or (III) are not defined in the specification so as to know the structures of

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the compounds that are included and/or excluded by the term. Therefore, the specification lacks adequate support for Claims 14.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 is indefinite for the reasons set forth above under 35 U.S.C. 112, first paragraph. Claim 14 involves the process steps: (a) oxidation of a compound of formula (II) or are protected derivatives thereof or (b) reaction of a compound of formula (III) or are protected derivatives thereof. However, the "protected derivatives" of the compounds of Claims 14 is not defined in the claim so as to know the metes and bounds of the claims. Therefore, the claim is indefinite.

**III. Conclusion**

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

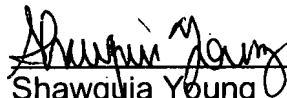
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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

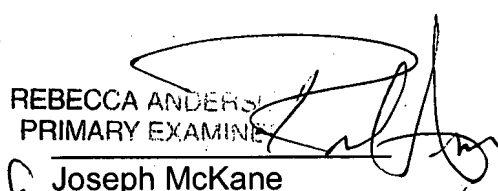
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 7:00 AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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